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10/731,061	12/09/2003	Christopher John Peltz	200314177-1	3736

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EXAMINER

ANTONIENKO, DEBRA L

ART UNIT	PAPER NUMBER
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3689

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/731,061	Applicant(s) PELTZ, CHRISTOPHER JOHN	
	Examiner DEBRA ANTONIENKO	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003 and 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26, 28, 29, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26, 28, 29, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Non-Final Office Action in response to communications received December 9, 2003 (Application) and December 23, 2008 (Response to Restriction Requirement), wherein:

Claims 1-22, 27, and 30 have been cancelled;

Claims 31 and 32 have been newly added; and

Claims 23-26, 28-29, and 31-32 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24-26, 28-29, and 31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 23 and 26 recite the limitation to produce a metaplan and then a plan from the metaplan. According to the instant specification, a *metaplan can be considered a plan about planning* ([0010]). In other words, the limitation is to produce ideas about ideas. The instant specification discloses what amounts to collecting ideas for a plan or brainstorming. This is old and well known. It is unclear how the invention

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actually produces a metaplan without using what is already known in the art. Claims 24-25 are dependent and are rejected in a like manner.

Claims 24, 28, 31 recite the phrase “establishing...criteria.” Similar to above, the instant specification provides brainstorming activity to establish criteria. It is unclear how the invention actually establishes criteria. Claims 29 and 32 are dependent and are rejected in a like manner.

Claim 31 further recites the terms “identifying” and “determining.” It is unclear how this is being accomplished. Does a human do the identifying and determining?

4. The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 uses the means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. For example, it is unclear what the means are “for producing a ... metaplan.” The instant specification states that *a metaplan is an article of manufacture that facilitates planning* ([0010]). It is unclear what manufacturing is taking place. The instant specification further states a *metaplan can include items to consider when making a plan* ([0010]). It is unclear how a collection of ideas is a tangible object.

Applicant is required to: (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either: (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(o).

Claim 31 recites the limitation “one or more sets...comprises” which means that any one of the following sets is sufficient. However, the last phrase in the claim recites “one or more members of the first through seventh sets” which means all seven sets are needed. It is unclear what Applicant intends as the limitation.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 23-26, 28-29, and 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to Claims 23-25: Independent Claim 23 states that the invention is directed to a system, however, no structure has been recited. A system should be defined by structure and positively recited in the claim in order to be statutory. Furthermore, it is unclear exactly what the "logic configured" is. Logic configured can be considered software per se which does not fall into one of the four statutory classes. There must be an apparatus as well that is capable of executing the software appropriately in order to provide functionality. Claims 24-25 are dependent and are rejected in a like manner.

As to Claim 26: Independent Claim 26 recites a system with means for. It is unclear in the instant specification what the structure is that provides the functions.

As to Claims 28-29 and 31-32: In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class such as a particular machine that imposes meaningful limits on the method claim's scope or (2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

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With respect to independent Claim 28, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. Claims 29 and 31-32 are dependent and are rejected in a like manner.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 23-26, 28-29, and 31-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff, U.S. Patent Application Publication Number 2004/0143477 A1 (hereinafter Wolff).

Regarding Claims 23-24 and 28-29, Wolff teaches a system and method, respectively, comprising: establishing one or more sets of criteria for characterizing a ...project; and producing a ...project metaplan from one or more elements of the one or more sets of criteria... producing a Web services project plan from the Web services project metaplan. Wolff teaches the initial set-up of *primary modules*. These modules contain *meta-knowledge (i.e., knowledge about the particular products' design, development, or management) to be employed, helping to guide the focus of the various product management processes ([0031]-[0033])*. Wolff teaches the use of *success criteria* in the modules (Figure 7). Wolff teaches the use of templates that *may be selected from a set*

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of default templates and that *confidence factors may be specified for the tasks of the project* ([0009]-[0018]). Examiner asserts that although Wolff does not use the term "*metaplan*," Wolff does indeed teach establishing criteria in the modules and then using the modules to produce the plan (Figure 4). Examiner asserts that giving a new name to something old and well known does not effectively serve to patentably distinguish the claimed invention over the prior art.

Furthermore, Wolff does not specifically disclose the invention for a Web services project. However, Wolff teaches the method and system for managing a project to include *a good to be sold commercially, an information technology project to be implemented, or another type of project* (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a Web services project along with other types of information technology projects because the planning principles would be the same.

Regarding Claim 25, Wolff further teaches providing one or more values for one or more members of the one or more sets of criteria ([0064]).

Regarding Claim 26, Wolff teaches a system, comprising: means for producing a project metaplan; means for producing a project plan from the project metaplan. Wolff teaches the initial set-up of *primary modules*. These modules contain *meta-knowledge (i.e., knowledge about the particular products' design, development, or management) to be employed, helping to guide the focus of the various product management processes*

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([0031]-[0033]). Wolff teaches the use of *success criteria* in the modules (Figure 7).

Wolff teaches the use of templates that *may be selected from a set of default templates* and that *confidence factors may be specified for the tasks of the project* ([0009]-[0018]).

Examiner asserts that although Wolff does not use the term "*metaplan*," Wolff does indeed teach establishing criteria in the modules and then using the modules to produce the plan (Figure 4). Examiner asserts that giving a new name to something old and well known does not effectively serve to patentably distinguish the claimed invention over the prior art.

Wolff further teaches means for refining the project plan based on feedback data acquired from testing one or more portions of a project built according to the project plan ([0069]).

Furthermore, Wolff does not specifically disclose the invention for a Web services project. However, Wolff teaches the method and system for managing a project to include *a good to be sold commercially, an information technology project to be implemented, or another type of project* (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a Web services project along with other types of information technology projects because the planning principles would be the same.

Regarding Claim 31, Wolff further teaches where the establishing one or more sets of criteria comprises: establishing a first set of criteria for calculating a project return on

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investment ([0185]); establishing a second set of criteria for identifying an existing reusable software component; establishing a third set of criteria for identifying how to expose an existing software asset via a Web service; establishing a fourth set of criteria for determining whether to include a Web service in a Web services project; establishing a fifth set of criteria for determining whether to employ a Web services supporting technology; establishing a sixth set of criteria for identifying a Web services development team; establishing a seventh set of criteria for identifying one or more of, a project collaboration partner, and how to collaborate with a project collaboration partner; and selectively organizing one or more members of the first through seventh sets of criteria to produce the Web services project metaplan.

10. **Claim 32** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Lai, U.S. Patent Application Publication Number 2005/0044197 A1 (hereinafter Lai).

Regarding Claim 32, Wolff does not explicitly teach developing a strategy for developing the Web services project that includes one or more Web service components; programming a Web service component of the Web services project based on the strategy; testing the Web service component; calculating the effect of the Web service component on a return on investment for the Web services project; and selectively updating the strategy based on the effect of the Web service component on the return on investment.

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However, Lai discloses developing a strategy for developing the Web services project that includes one or more Web service components; programming a Web service component of the Web services project based on the strategy; testing the Web service component ([0419]; Figure 19); calculating the effect of the Web service component on a return on investment for the Web services project ([0256]). Lai does not explicitly disclose selectively updating the strategy based on the effect of the Web service component on the return on investment. However, Lai discloses *an option is to use an iterative development process with appropriate user involvement for feedback... Web Services solution release preferably delivers quantifiable business value... Web Services infrastructure and integration implementation... preferably does not exceed the business value delivered (such as the sum of cost... ([0454]-[0457])*. It is old and well known to quantify the business value of projects and to change or update decisions in the interest of the bottom line. In other words, how many times ROI is calculated or at what points ROI is calculated or if a strategy is changed because of the ROI is a matter of common business sense. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wolff with that of Lai to develop a strategy, program and test it, and to calculate the profitability as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is

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(571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
2/16/09